(4) REMARKS

COUNTER-ARGUMENT TO ACTION PARA. 5 "Response to Arguments"

(A) In Re Independent Claim 1 and dependent claims 2-3

The Office alleges:

> "Referring to the arguments concerning claim 1, the applicant argues that the Bates reference is insufficient in anticipating the claimed invention. That argument is incorrect."

First, Bates was cited under Sec. 103 with respect to making the present invention obvious. Applicant made no such Sec.102 argument. The Response is both a *non sequitur* and simply conclusory. In his previous amendment paper from Page 8, line 22, through Page 10, line 11, applicant describes exact technical differences between Bates and the present invention, including direct quotations from applicant's claim 1 as to those differences. In accordance with those arguments, incorporated herein by reference, Bates has been shown as not standing for the technical propositions it is used for by the Office. Yet the Final Office Action inexplicably dismisses these argument. Applicant requests an explanation as to why his "...argument is incorrect."

Secondly, the Action goes on to state:

> "The applicant sites [sic, "cites"] differences such as Bates lacks the use of a "temporary mnemonic-type free had [sic, hand] writing", however the claim language never suggest such a limitation."

Yet, at page 8, lines 26, of the prior amendment the applicant clearly cites directly from his claim 1 and states:

> "Claim 1 by Lemon herein specifies,
> "**...an electronic tablet *having visible marking capability*;**
> **a marking stylus associated with the tablet;" *****

" ...device for associating at least one *temporarily marked location* ...". "

It is known in the art that fundamentally "an electronic tablet" with an associated "marking stylus" is by definition a "free-hand writing" computer peripheral. Thus the claim not only "suggests such a limitation," it by definition includes exactly such a limitation. Moreover, claim 1 goes on to read:

> **"...temporarily marked location *on said tablet* with a preselected Internet data address wherein *subsequently accessing said marked location with said stylus* triggers a shift to said data address associated with said marked location."**

When read in its entirety, this clearly describes a freehand marking by which the user makes marks which remind him of each addresses content. The statement in the Final Office Action that:

> "Furthermore, in response to the argument that the icon is a computer-generated representation is also moot since, [sic] nowhere in the claim does the applicant suggest otherwise."

is refuted by the very language just cited, viz., the marked location is "***on*** said tablet." No other interpretation is logical.

At page 9, lines 3-16, of the prior amendment, applicant sets forth why Bates *on-screen icon generator* is non-analogous.

Further, the Office must consider the complete lack of identity of elements of claim 1 and the sole reference Bates:

LEMON	BATES
(1) A computer annotator system for accessing Internet data addresses...	(1) AUTOMATIC ICON GENERATION (see e.g., title, abstract)
(2) an electronic tablet having visible marking capability	(2) possibility of using a tablet *as a mouse pointer* (col. 5, ll. 26-29); mouse 118 as preferred embodiment (col. 5, ll. 53-58)
(3) marking stylus associated with the tablet	(3) no disclosure
(4) associating at least one temporarily marked location on said tablet; claim 2: tablet having...surface region...	(4) no disclosure; the whole patent is to *on-screen* icon generation (see e.g., col. 2, ll. 20-22; col. 8, ll. 39 - 43, FIG 11 10, 11B, 11C, 12 described as "display screen contents," col. 2, ll. 59-61)
(5) associating at least one temporarily marked location on said tablet with a preselected Internet data address wherein subsequently accessing said marked location with said stylus triggers a shift to said data address associated with said marked location	(5) requires extracting from word-icon database 316 (see e.g., col. 8, line 58 et seq.)

One can only conclude from this side-by-side comparison that Bates utterly fails to show the functionality as set forth in claim 1 of the present application in every aspect. The law and the regulations or procedures call for the Office to produce evidence from the text of one or more references that all of the elements of a claim are known. If more than one reference, the Office must justify that elements thereof can be combined for the same function or a similarity such that no improvement to the state of the art is shown in the examined application. In Ex parte Levengood, 28 USPQ2d 1300, the Board of Patent Appeals and Interferences stated:

> "In order to establish a prima facie case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference *in the applied prior art*, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teaching of the applied references in the proposed manner to arrive at the claimed invention."

Here, as shown in the table above, the conclusion that Bates renders the Lemon invention and the claim obvious is a *non sequitur* to the actual teaching of Bates. There is simply no correlation. Even then,

> "That 'features,' even distinguishing features, of the claimed invention are disclosed in the prior art is not alone sufficient to compel a conclusion of obviousness. It is common to find features somewhere in the prior art, but it is not features but the subject matter as a whole that must be evaluated." Patents and the Federal Circuit, Hammon, Ch. 4, Sec. 4.5, page 72 (1988 Ed), citing Connell v. Sears, Roebuck & Co., 722 F.2d, 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983).

Bates in its own words is a mechanism for generating screen icons for use in the future; the Lemon claim is for creating immediate, visible, temporary links to web sites via an electronic writing tablet mnemonic. To equate the two based on some believed similarity of elements disregards elements of the whole Lemon invention, its purpose, the problems solved and the improvements to the state of the art.

Next, the Final Office Action states:

> "The applicant also argues that the difference [sic, between Bates and claim 1 is ?] between absolute and relative coordinate mode, a limitation that is also absent from the claim language."

In the context of the prior amendment paper, applicant was clearly discussing *the Office's claim* that Bates discloses a writing tablet as used by Lemon. In fact, Bates in his own words is actually stating that a tablet can be a mouse pointer. This is can not be interpreted as indicative of using a tablet in the functionality of the present invention, namely, making a freehand mnemonic writing which becomes an instant access point to a web site address which is what applicant was trying to explain. Therefore, as emphasized hereinabove, there is no logical obviousness conclusion to be drawn. Moreover,

> "[T]he law does not require all of the claims to recite each and every element necessary to the operation of the invention ... Were this not the case, the claims would be prolix to the point of obscuring the inventive concept to which the claims are directed. It is the function of the specification, not the claims, to set forth sufficient detailed information to enable one skilled in the art to make or use the invention. . .." General Electric Co. V. United States, 206 USPQ 260, 283-4 (Ct. Cl. Trial Div. 1979), aff'd. on other grounds, 654 F.2d 55, 211 USPQ 867 (Ct. Cl. 1981).

Lemon's claim is clear and distinct, including how the tablet is used other than as a mouse point and click device.

Next, the Final Office Action states:

> "Finally, spontaneity is not claimed formally claimed [sic] by the applicant. Even if the spontaneous requirement was somehow established in the claim language, Bates' invention also allows for the spontaneous creation of an Internet shortcut."

Yet, claim 1 clearly reads:

> **"associating at least one *temporarily marked location on said tablet* with a preselected Internet data address wherein *subsequently accessing said marked location with said stylus triggers a shift* to said data address associated with said marked location."**

Spontaneity is claimed *prima facie*. Bates clearly requires use of a "word-icon *database 316*". Col 8: ll. 58 et seq.; col. 9, ll. 5-6. Such a database by definition is not

> "spontaneous;" "occurring, acting, or arising without apparent external cause. 2. produced or done naturally and voluntarily." Webster's II New Riverside Dictionary, Houghton Mifflin Company, NY, copr. 1996.

A database has no such capability as one must recognize from reading the present specification and claims wherein a freehand mnemonic on a tablet becomes a trigger to a web site.

The Office's Response to Arguments regarding claim 1 and its dependent claims is technologically unsupportable from Bates. Withdrawal of the rejection is respectfully requested.

(B) In re Claim 3

Claim 3, as amended hereinabove, states:

> **"...said *tablet* having at least one predetermined second *surface region accessible to said stylus* wherein *freehand symbols* indicative of the preselected data address *are entered.*"**

The Final Office Action first states:

> "...the examiner believes firmly that Internet address [sic, "addresses"] are known in the are as being commonly referenced values in computing devices."

This misses the point and ignores the claim and the specification from which it is derived. Applicant is not claiming Internet addressing *per se*. As a whole the claim describes further detail as to how the tablet implements the spontaneous creation of the mnemonic web site access link.

The Final Office Action goes on:

> "A computer address (used in the context of Weber's invention" is a memory location dedicated for storage. As ones skilled in the art understands as demonstrated by the numerous references sighted [sic, "cited"] (Bates and Dickman) Internet addresses are

being stored/bookmarked to allow quick access to favorite Internet sites. Internet address is a specific type of address storage that is commonly known in the art and neither personal hindsight nor extrapolation was used to determine this relationship."

This in fact proves applicant's point. In the prior art there is some element which is "stored/bookmarked" in a preset manner *in the computer for on-screen use*. Those must be created on-screen using Bates software or by some other means and so stored for future use. None of those mechanisms is applicant's "temporarily marked" mnemonic on a "tablet" which provides direct access to the web site. A careful reading of applicant's argument of the prior amendment makes clear that it does not state that Internet addressing is from hindsight. What is hindsight and extrapolation from any of the cited references is a finding of obviousness that the applicant's claimed *creation of temporary Internet site access points on the tablet using a freehand mnemonic.*

(C) In re Claims 5-15 and 7-20

The Final Office Action alleges:

"...the arguments regarding the rejection of these claims are merely recitations of the original claim or assertions that the examiner is incorrect. The applicant offers no new arguments..."

This is simply inaccurate description of applicant's submission and conclusory in itself. Applicant does cite claim language verbatim because *that is the issue*. In each case, applicant clearly adds emphasis in the nature of underlining and italics to show specific claims' elements which are "...different aspects not disclosed, suggested, nor motivated by Bates nor by a combination of Bates and Weber et al...". Those are the "new arguments." Those claimed elements are nowhere to be found in the references own words or even via suggestions. Therefore the Lemon claims are so shown to be patentably distinguished by those highlighted elements. The Office does not point to citations to any language within the cited references, in the language of the references, disclosing those elements. The applicant, in the prior amendment and herein has refuted on technical grounds each actual reference to columns/lines of Bates or Weber that the Actions cited. By doing so, and by pointing out the emphasized

elements in the claims, applicant has shown that it is the prior Office Action, Paper 9, that reaches conclusions not supported except by impermissible hindsight using the present application as a template to try to correlate elements which are technologically different in type and function.

Keeping in mind that applicant's specification and claims are clearly directed to how the tablet implements the spontaneous creation of the mnemonic web site access point, it is worth carefully reconsidering applicants prior argument against Weber here:

> "Weber et al. is understood by the applicant to be merely a fundamental patent to the computer tablet product line and **a different problem** related thereto. Weber's claim 26, for example, is to "**An interactive, processor-controlled system for *storing in a data structure* for *later retrieval* time-stamped, handwritten information entered by a system user; ...**" This is a highly different, **persistent storage** approach. *The present applicant neither stores nor retrieves from a data base. Applicant Lemon's mnemonic marks exist only e.g. as ink on paper covering a tablet.* Moreover, **Weber's indexing scheme must employ a system clock for the time stamping and uses those events to link written notes.** *The present invention is to the opposite in that it uses written mnemonic marks to link web pages without such requirements.*

The Final Office Action states there are:

> "...mnemonic representations, associated with a specific location within the tablet, that refer to particular addresses in computing memory..."

Weber is "facilitating note-taking tasks" See e.g., Abstract. It is not an immediate indexing of web sites at all. The addresses relate to creating the ability to recognize handwriting on a tablet. In his own words, Weber is *storing* something for *later access*. To the exact opposite effect, in the independent claims, applicant claims:

> "5. A method for *indexing* computer-accessible Internet sites, the method comprising:
>
> accessing a first of said sites;

associating an address indicative of the first of said sites with a first location coordinate address *on a computer writing tablet* via a first visible *marking a first random location* on said writing tablet *during access* of said first of said sites;

accessing a second of said sites; and

associating an address indicative of the second of said sites with a second location coordinate *address on the computer writing tablet* via a second visible marking on a second *random location* on said writing tablet *during access* of said second of said sites.

Claim 8 also is clearly for an entirely different purpose:

8. A method for using a computer writing tablet, the method comprising:

associating an input-output port of the tablet with signals indicative of Internet-associated computer data addresses;

when each of a plurality of the Internet-associated computer data addresses is accessed, *writing a mnemonic object associated therewith* respectively, wherein a location on said tablet of the mnemonic object is coupled to *a current one* of said Internet-associated computer data addresses; and

accessing any specific one of said plurality of the Internet-associated computer data addresses by selecting the mnemonic object associated therewith.

Similarly, claims 11, 15, and 17 are for an entirely different purpose, solving entirely different problems:

11. A computerized method comprising:

accessing an internet site; and

associating an *address* of the site *with a writable-erasable mnemonic device* in a computer writing tablet such that said site is *re-accessible directly from said writable-erasable mnemonic* device.

15. A computer memory comprising:

computer code for recording *temporary symbols* associated with an Internet site address;

computer code associating the Internet site address with a writable-erasable mnemonic device in a computer writing tablet for receiving said temporary symbols; and

computer code for *accessing* said Internet site address via said *temporary symbols.*

17. An internet search tool comprising:

an *internet access* device;

in communication with the internet access device, a writing tablet and associated inking stylus; and

associated with the combination of internet access device, writing tablet and stylus, program code using said tablet for *generating bookmarks* ***thereon*** related to respective search resultant internet sites such that said *sites are accessible directly via said bookmarks*.

From a logical standpoint, the combination of Bates plus Weber creates a system which generates storable permanent on-screen display icons using handwriting. It is only, at best, by hindsight using Lemon's application that one can take Bates -- an on-screen icon generating technique -- and combine it with Weber -- a handwriting recognition technique -- and conclude that therefore Lemon's tablet which implements spontaneous creation of the mnemonic web site access point from the tablet is obvious.

Withdrawal of the rejections is respectfully requested.

SUMMARY AND CONCLUSION

The amendments to the claims submitted herein merely emphasize the distinguishing features from the cited art as fully briefed in the REMARKS section above.. No new elements have been extracted and inserted from the specification; no new search is required.

It is respectfully requested that the application be reconsidered and allowed.

Questions or suggestions that will advance the case to allowance may be directed to the undersigned by teleconference at the Examiner's convenience.

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Respectfully submitted,
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